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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,568	04/14/2004	Brian T. Chait	0112602.00152US23	9114
23483	7590	02/01/2008		
WILMERHALE/BOSTON 60 STATE STREET BOSTON, MA 02109			EXAMINER AUDET, MAURY A	
			ART UNIT 1654	PAPER NUMBER
			NOTIFICATION DATE 02/01/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/825,568	CHAIT ET AL.	
	Examiner	Art Unit	
	MAURY AUDET	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 526-585 is/are pending in the application.
- 4a) Of the above claim(s) 529, 532-535, 537, 539-542, 552, 553 and 555-576 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 526-528, 530, 531, 536, 538, 543-551, 554 and 577-585 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/07, 1/05, 9/04, 7/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The present application has been transferred from former Examiner Khana to the present Examiner. This Examiner acknowledges the parent application patent number 6,824,981. Notwithstanding the '981 application and prosecution/examination thereto, Applicant is reminded that each application is examined on its own merits. (Another application S.N. 11/344,801, US Publication 20070207555, has also been filed, but to specific reporter peptides that do not overlap the presently elected SEQ ID NO: 1).

Election/Restrictions

Applicant's election with traverse of Group I, claims 526-554 and 577-586, as drawn to the peptide SEQ ID NO: 1 (Cys Gly Gly Gly Gly Asp Pro Gly Gly Gly Gly Arg) in the reply filed on 7/23/07 is acknowledged. The traversal is on the ground(s) that it would not be an undue burden to search all the peptides claimed. This is not found persuasive because the peptides are independent and distinct and searching more than one not containing at least an overlapping core would constitute an undue search burden (each peptide sequence requires a search of 5-7 peptide databases and examination of the results of each database for each peptide search).

As the previous Examiner had required:

In Groups I-II, the species of SEQ ID NO: 1, 24-26 and isotopic variants thereof are independent or distinct because they are drawn to varying lengths having different

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sequences and chemical structures. It would be an undue burden to examine all the species in one application particularly with respect to their being non-obvious variants.

Applicant is required under 35 U.S.C. 121 to elect a single Group, within that Group a single SEQ ID NO., and elect a completely defined species of that SEQ ID NO. represented by the positions of the isotopes or chemical reactive groups, even though this requirement is traversed.

Notwithstanding the above, this Examiner was willing to search the elected peptide of SEQ ID NO: 1 and any other peptides bearing the same overlapping core (as Applicant indicated, 4 heavy glycines). HOWEVER, of the 18 peptides Applicant has described in the sequence list/specification, no other peptides were found to contain an overlapping core with that of elected SEQ ID NO: 1. Thus, the only peptide that could be searched commensurate in scope with the elected species, without an undue search burden, was that of the elected peptide of SEQ ID NO: 1.

Claims 555-576 are pending. Claims 529,532-535,537,539-542,552,553 and 555-576 are withdrawn. Claims 526-528,530,531,536,538,543-551,554 and 577-585 are examined on the merits as drawn to SEQ ID NO: 1.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 526-554 and 577-585 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over at least claim 1-20 and 80-83 of U.S. Patent No. 6,824,981 (parent of present application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application's elected species (SEQ ID NO: 1) constitutes a species within the genus of the '981 patent (set/kits containing same reporter peptides drawn to overlapping descriptions), wherein reporter peptides are the same described within the present application, which make up the set claimed in '981.

Claim Objections

Claims 580 and 585, line 2, is objected to because of the following informalities: term "of" should be spelled --or--. Appropriate correction is required.

Allowable Subject Matter

The prior art of record does not reasonably teach or render obvious a peptide selected from the group consisting of the elected species of SEQ ID NO: 1, having 4 heavy chain glycine; or set or kit thereto. Were claims 526-554 and 577-585 amended thereto (reporter peptide consisting of SEQ ID NO: 1), the claims would likely receive favorable consideration.

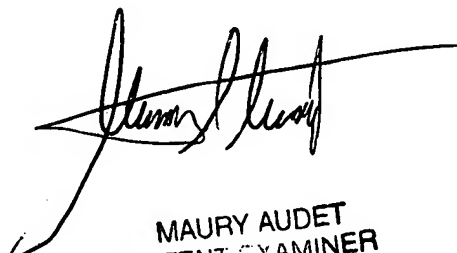
Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MAURY AUDET
PATENT EXAMINER